

REMARKS

I. Status of claims

Claims 1-20 are pending in this application. By this Amendment, claims 6 and 7 have been amended to correct minor typographical errors. Entry of this Amendment after Final Rejection is considered proper because it simplifies issues for Appeal. Reconsideration of the rejection is respectfully requested in view of the above amendments and the following remarks.

III. Claim Rejections

Claims 1-20 have been rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,699,527 to Davidson in view of U.S. Patent No. 5,870,721 to Norris. This rejection is respectfully traversed.

Applicant notes that in order to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Edward S. Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994).

Pending independent claims 1 and 6 are directed to a method or system for sending a loan document to a customer. With respect to claim 1, a web-enabled customer interface is provided which receives loan information from the customer. A network is coupled to the customer interface and the network receives the loan information from the customer interface. The system of claim 1 additionally includes a web site coupled to the network. The web site receives the loan information and merges the loan information with a loan application form to produce a loan application. The system additionally includes a loan processor coupled to the web site. The loan processor receives the loan application, performs a credit check on the customer based on the

loan application, and determines whether the customer should receive a loan based on the credit check. The system additionally includes a document server coupled to the loan processor. The document server generates and sends the loan document to the customer, based on the loan application. When the loan processor determines that the customer should receive the loan, the loan processor sends the loan document to the customer through one of email, facsimile, the network, a first printer coupled to the network, and a second printer coupled to another network.

The primary reference, Davidson, is directed to an automated method for assisting a bank customer with filling out a loan application. The system disclosed by Davidson lacks several features of claims 1 including at least (1) a web-enabled customer interface which receives loan information from the customer (2) a web site coupled to a network for receiving customer loan information; (3) the web site merging loan information with a loan application form to produce a loan application; (4) a loan processor coupled to the web site that performs a credit check based on the loan application; and (5) a document server that generates loan documents and sends them to the customer.

With respect to item (1), Davidson fails to provide a web-enabled customer interface. Davidson merely suggests providing an electronic connection between computers in order to download Loan Software (LS).

The concept of sending electronic text messages between parties in a way analogous to mailing letters or memos predates the creation of the Internet and the World Wide Web. Additionally, the creation of the Internet pre-dates the creation of the World Wide Web. When Davidson submitted his patent May 1, 1995, the World Wide Web was in its infancy and did not even have the capability to implement the claimed system. Although development of HTML, the original programming language of the World Wide Web, began in 1991, it did not become a

standard until at least November of 1995. (See, for example, information resources for “HTML” in Wikipedia.)

Applicants further note that the Internet and the World Wide Web are two distinctly different concepts. The Internet is a global data communications system that pre-dates the World Wide Web. It is a hardware and software infrastructure that provides connectivity between computers. In contrast, the World Wide Web is one of the services communicated via the Internet. It is a collection of interconnected documents and other resources, linked by hyperlinks and URLs. (See information resources for “Internet” in Wikipedia.)

With respect to item (2), Davidson fails to provide a web site. Applicants respectfully request that the Examiner identify any language in Davidson that is relevant to the provision of a web site. The previous Office Action referenced Col 6, lines 20-39 of Davidson. This section describes a process through which a loan applicant may seek help from a program stored on the loan applicant’s own computer. The current Office Action references Col. 5, lines 24-26, Col. 6, lines 6-8 and Fig 3D. In fact, the description of FIG. 3D, specifically referenced by the Examiner provides that the LS program is downloaded to the loan applicant computer. Such downloading of a program would be entirely unnecessary if the loan applicant were accessing a web site.

None of these sections even remotely refers to the existence of a web site. These sections reference an applicant computer connected via modem to a lending institution computer. Computers have been connected to one another via modem long before the existence of web sites and the World Wide Web. Various computer networks were available prior to the existence of the World Wide Web.

The statement in Davidson that the computer is an “online” service computer in the reference further provides no suggestion of a web site. “Online” is defined, for example in Wikipedia as a condition specified by Federal Standard 1037C. Online is a state or condition of a "device or equipment". To be considered online, one of the following must apply to a device: The device must be under the direct control of another device, under the direct control of the system with which it is associated, available for immediate use on demand by the system without human intervention, connected to a system, and is in operation, or is functional and ready for service. An additional simpler definition of “online” is provided by The Free Dictionary, which states that online means “under the control of a central computer” or “connected to a computer or computer network.”

The claimed use of a web site relates to an entirely different concept. One definition of a web site offered by the “Free Online Dictionary” defines a web site as a set of interconnected webpages, usually including a homepage, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization. In the same resource, a web page is defined as a document on the World Wide Web, consisting of an HTML file and any related files for scripts and graphics, and often hyperlinked to other documents on the Web.

Wikipedia defines a web site as a collection of web pages, images, videos or other digital assets that is hosted on one or more web servers. Wikipedia further defines a Web page as a document, typically written in (X)HTML, that is almost always accessible via HTTP, a protocol that transfers information from the Web server to display in the user's Web browser.

The references applied by the Examiner do not provide a web-based system. Computers have been connected to one another via modem for decades, long before web sites even existed. Davidson is indicative of the state of the art prior to the existence of the World Wide Web.

With respect to item (3), as set forth above, Davidson fails to provide a web site. Instead, a program running on a customer's own computer receives customer information or the customer computer may be directly connected via modem to a bank computer. Furthermore, the loan servicing (LS) program running on the customer's own computer creates the loan data file. Thus, Davidson fails to provide a web site merging loan information with a loan application form to produce a loan application.

With respect to item (4), the Office Action acknowledges that Davidson fails to provide a loan processor coupled to the web site that performs a credit check based on the loan application.

With respect to item (5), the Office Action references Column 7, lines 6-11 to show a document server that generates loan documents and sends them to the customer. On the contrary, this portion of Davidson merely specifies that the loan document may be printed. It does not provide any disclosure that indicates that the system generates loan documents and sends them to the customer.

The secondary reference, Norris, is directed to a system and method for real time loan approval. The system is directed towards enabling a customer to access a kiosk having a voice communication processor that allows the customer to provide verbal information relevant to the loan process. Norris also fails to provide a web-based system and therefore does not obviate the deficiencies of Davidson noted above. Given that the Norris application was filed in August of 1993, Norris would not have contemplated a system incorporated in the World Wide Web.

Thus, even if combined, Davidson and Norris would not have resulted in the invention of claim 1. Accordingly, a *prima facie* case of obviousness cannot be established. Specifically, before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. See MPEP §2143. .

Furthermore, no motivation would have existed to modify Davidson with the disclosure of Norris. Davidson is directed to a computer program to be installed on a loan applicant's computer. The program receives information from the applicant and creates a loan file based on that information. This system facilitates lending institution processing by providing information to the lending institution in an acceptable format. The program leads to a standardization of paperwork to enable any lending institution employee to review and understand the loan file without consulting with the loan officer. See Column 2, lines 1-29 of Davidson. Thus, Davidson does not contemplate automating the entire process so as to minimize participation of lending institution employees. In fact, eliminating participation of lending institution employees as suggested by Norris would have been contrary to the objectives of Davidson.

Thus, the combination of the teaching of Davidson and Norris is insufficient to establish a *prima facie* case of obviousness against claim 1 because the combination of references fails to disclose each claimed feature and because no motivation would have existed to combine the references.

Independent claim 6 sets forth similar limitations to those set forth above with respect to claim 1 in method form and therefore defines over the art of record for reasons parallel to those set forth above with respect to claim 1. Specifically, claim 6 requires receiving loan information from the customer over a network by a web site hosted by a loan approval system computer and merging, at the loan approval system computer, the loan information with a loan application

form to produce a loan application. Claim 6 further requires performing a credit check on the customer based upon the loan application and determining at the loan approval system computer, whether the customer should receive the loan based on the credit check. Claim 6 further requires, upon customer approval, generation and sending of a loan document associated with the loan and based on the loan application, wherein the document is created at a loan document creation server connected with the loan approval system computer and the loan document creation server includes a forms database for producing loan documents related to an approved loan application, the sending being through one of e-mail, facsimile, the network, a first printer coupled to the network, and a second printer coupled to another network.

The combination of Davidson and Norris fails to disclose these features and therefore a *prima facie* case of obviousness has not been established. For instance, in addition to the features set forth above with respect to claim 1, Davidson and Norris fail to disclose generation and sending of a loan document associated with the loan and based on the loan application, wherein the document is created at a loan document creation server connected with the loan approval system computer and the loan document creation server includes a forms database for producing loan documents related to an approved loan application.

Claim 7 defines a method for creating a loan contract between a customer and a bank, the loan contract including terms where the bank loans money to the customer, and terms where the customer is obligated to pay the money back to the bank. The method involves the bank receiving loan information from the customer at a web site hosted by a loan approval system computer and merging, at the loan approval system computer, the loan information with a loan application form to produce a loan application, the loan information indicating the terms. The method additionally includes the bank processing the loan information at the loan approval

system computer to determine whether the bank desires to enter into the loan contract, the processing including automatically requesting and evaluating a credit report through the loan approval system computer. If the bank desires to enter into a loan contract based on evaluation of the credit report through the loan approval system computer, the bank generates a loan document by accessing a loan document creation server connected with the loan approval system computer and sends the loan document to the customer, the loan document being based on a loan application and associated with the loan contract and listing the terms. The method further includes sending a check to the customer, the check corresponding to the loan contract. thereafter, the customer performing the steps of receiving the loan document; receiving the check; and negotiating or cashing the check; whereby cashing the check indicates acceptance by the customer of the terms listed in the loan document.

As set forth above, even if combined, Davidson and Norris fail to disclose each and every claimed feature. For instance, neither Davidson nor Norris discloses receiving loan information from the customer at a web site hosted by a loan approval system computer and merging, at the loan approval system computer, the loan information with a loan application form to produce a loan application, the loan information indicating the terms. Furthermore, neither Davidson nor Norris discloses the bank generating a loan document by accessing a loan document creation server connected with the loan approval system computer and sending the loan document to the customer, the loan document being based on a loan application and associated with the loan contract and listing the terms and sending a check to the customer, wherein the check corresponds to the loan contract. Furthermore, neither Davidson nor Norris discloses the subsequent steps of the customer performing the steps of receiving the loan document; receiving

the check; and negotiating or cashing the check; whereby cashing the check indicates acceptance by the customer of the terms listed in the loan document.

For at least the reasons set forth above, Davidson, even when combined with Norris, does not teach or suggest the components of the system defined by pending independent claims 1, 6, and 7. Accordingly, the Office Action does not establish a *prima facie* case of obviousness.

The Office Action fails to establish a *prima facie* case of obviousness that the pending claims are unpatentable. “During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability.” *In re Glaug*, 283 F.3d 1135, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002). “If the PTO fails to meet this burden, the applicant is entitled to the patent.” *Id.* “To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int.. 1985). The references applied in the Office Action fail to suggest the claimed invention for at least the reasons set forth with regard to each claim below. An artisan of ordinary skill would not have found the claimed invention to have been obvious in light of the teaching of the applied references. As the Examiner has not presented a *prima facie* case of unpatentability, applicant is entitled to a patent.

Claims 2-5 depend from claim 1, and define over the art of record for at least the reasons set forth above with respect to claim 1. Claims 8-20 depend from claims 1, 6, and 7 and therefore define over the art of record for at least the reasons set forth above with respect to claims 1, 6, and 7. Accordingly, withdrawal of the rejection of claims 1-20 under 35 U.S.C. §103 is respectfully requested.

III. Conclusion

As set forth above, applicants respectfully submit that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicants have overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

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Respectfully submitted,

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